IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	**PHILYAW, Jeffry Jovan**	
Application Serial No.:	**10/791,678**	**Conf. No.: 2622**
Filing Date:	**March 2, 2004**	
Group:	**2141**	
Examiner:	**COULTER, Kenneth R.**	
Title:	**METHOD AND APPARATUS FOR ACCESSING A REMOTE LOCATION BY SENSING A MACHINE-RESOLVABLE CODE**	

BRIEF ON APPEAL

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BRIEF ON APPEAL

This Brief is submitted in accordance with 37 C.F.R. § 41.67 concerning the Notice of Appeal filed April 21, 2008, in response to the Final Office Action dated October 19, 2007, wherein the Examiner finally rejected Claims 1-36 that comprise all of the pending claims in this application.

I. Real Party Interest.

The party in interest is RPX-LV Acquisition LLC, a Delaware limited liability company, whose principal office and place of business is at 2711 Centerville Road, Ste. 400, Wilmington, Delaware 19808.

II. Related Appeals and Interferences.

Appellant has the following related-application pending appeals:

- U.S. Patent Application Serial No. 09/382,374, Appeal No. 2008-2956 entitled "METHOD AND APPARATUS FOR ALLOWING A BROADCAST TO REMOTELY CONTROL A COMPUTER" (Atty. Dkt. No. RPXC-24,736), filed August 24, 1999; and

- U.S. Patent Application Serial No. 09/382,426 entitled "METHOD AND APPARATUS FOR LINKING A WEB BROWSER TO A PROMOTION OFFER" (Atty. Dkt. No. RPXC-24,732), filed on August 24, 1999.

Appellant has filed a Notice of Appeal in the following related application:

- U.S. Patent Application Serial No. 10/780,109 entitled "REMOTE CONTROL HAVING AN OPTICAL INDICIA READER" (Atty. Dkt. No. RPXC-26,630), filed on February 17, 2004.

The above-identified patent application has no related interferences.

III. Status of the Claims.

Claims 1-36 from the application are pending, stand firmly rejected, and are on appeal here. A complete and current listing of Claims 1-36 are attached here in the **CLAIMS APPENDIX**.

IV. Status of Amendments.

Appellant filed an Amendment After Final on April 21, 2008 in response to the Final Office Action, mailed October 19, 2007, which did not amend the claims. An amendment filed August 07, 2007, was the last Response that amended the claims.

V. Summary of the Claimed Subject Matter.

The present invention, as set forth in Independent Claim 1, relates to a method of accessing one or more remote locations on a network by sensing a machine-resolvable code.[1] A first computer is disposed on the network.[2] The first computer is interfaceable to an input device

[1] See Specification Abstract and page 45, lines 7-23.
[2] See Specification page 45, lines 7-23.

for sensing a machine-resolvable code[3] proximate a first location and runs a software application, which includes a software identification code[4] that is unrelated to the machine resolvable code that has an association with at least one of the one or more remote locations.[5] The first computer accesses a second computer disposed on the network in accordance with routing information provided by the first computer[6] in response to the input device sensing the machine-resolvable code proximate the first location.[7] The software identification code is transferred from the second computer to the first computer.[8] Associations between software identification codes and ones of the one or more remote locations and operable to have routing information associated with each of the one or more remote locations is stored in an associative database at the second computer.[9] A lookup operation is performed at the second computer to match the software identification code with the associated at least one of the one or more remote locations in accordance with the stored associations to obtain associated remote routing information corresponding to the associated at least one of the one or more remote locations.[10] The remote routing is returned to the first computer from the second computer.[11] The first computer accesses the associated remote location according to the returned remote routing information to retrieve remote information from the remote locations associated with the returned remote routing information.[12]

The present invention, as set forth in dependent Claim 2, relates to the method of Claim 1, where the step of accessing with the first computer further is comprised of returning information from the associated at least one of the one or more remote locations to the first

[3] See Specification Figure 25, Reference #2506; and page 45, line 24-page 46, lines 1-23.
[4] See Specification Figure 25, Reference #2522.
[5] See Specification page 45, lines 7-23; page 45, line 24-page 46, lines 1-23; page 47, lines 11-19; page 47, line 20-page 48, lines 1-2; page 45, lines 3-9; page 48, line 10-page 49, lines 1-5 and page 49, lines 6-26.
[6] See Specification Figure 25; and page 46, line 24-page 47, lines 1-3; page 47, lines 4-10 and page 47, lines 11-19.
[7] See Specification page 47, lines 11-19; page 48, line 10-page 49, lines 1-5; page 50, lines 1-21 and page 51, line 15-page 52, lines 1-4.
[8] See Specification Figures 25 and 26; and page 47, line 20-page 48, lines 1-2; page 48, lines 3-9; page 48, line 10-page 49, lines 1-5 and page 51, line 15-page 52, lines 1-4.
[9] See Specification page 48, line 10-page 49, lines 1-5; page 50, line 22-page 51, lines 1-14 and page 52, line 22-page 53, lines 1-14.
[10] See Specification page 48, line 10-page 49, lines 1-5; page 49, lines 6-26 and page 52, line 22-page 53, lines 1-14.
[11] See Specification page 48, line 10-page 49, lines 1-5; page 49, lines 6-26; page 50, lines 1-21 and page 52, lines 5-21.
[12] See Specification page 49, lines 6-26; page 50, lines 1-21; page 52, lines 5-21 and page 53, lines 15-25.

computer;[13] and presenting at least a portion of the information so returned on the display of the first computer for presentation to the user.[14]

The present invention, as set forth in dependent Claim 3, relates to the method of Claim 1, where the software application running on the first computer converts the software identification code and generates routing information for transmission to the second computer in response to the sensing of a machine-resolvable code using the input device.[15]

The present invention, as set forth in dependent Claim 4, relates to the method of Claim 3, where the routing information includes the software identification code and the address of the second computer.[16]

The present invention, as set forth in dependent Claim 5, relates to the method of Claim 1, where the machine-resolvable code is an optical code and the input device is an optical code scanner.[17]

The present invention, as set forth in dependent Claim 6, relates to the method of Claim 5, where the optical code is a bar code and the optical code scanner is a bar code scanner.[18]

The present invention, as set forth in dependent Claim 7, relates to the method of Claim 6, where the bar code is a universal product code (UPC) bar code.[19]

The present invention, as set forth in dependent Claim 8, relates to the method of Claim 5, where the optical code is alphanumeric text and the optical code scanner is an optical character recognition (OCR) scanner.[20]

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[13] See Specification page 48, line 10-page 49, lines 1-5; page 49, lines 6-26; page 50, lines 1-21 and page 52, lines 5-21.
[14] See Specification page 49, lines 6-26; page 50, lines 1-21; page 51, line 15-page 52, lines 1-4 and page 52, lines 5-21.
[15] See Specification page 47, lines 11-19.
[16] See Specification page 51, line 15-page 52, lines 1-4.
[17] See Specification page 45, line 24-page 46, lines 1-23.
[18] See Specification page 45, line 24-page 46, lines 1-23.
[19] See Specification page 45, line 24-page 46, lines 1-23.
[20] See Specification page 45, line 24-page 46, lines 1-23.

The present invention, as set forth in dependent Claim 9, relates to the method of Claim 5, where the optical code is a portion of a display screen displaying a pattern of modulated brightness and the optical code scanner comprises a light sensor.[21]

The present invention, as set forth in dependent Claim 10, relates to the method of Claim 1, where the machine-resolvable code is an audio tone and the input device comprises a microphone.[22]

The present invention, as set forth in dependent Claim 11, relates to the method of Claim 1, where the machine-resolvable code is a magnetic pattern in a strip of magnetic material and the input device is a magnetic strip reader.[23]

The present invention, as set forth in dependent Claim 12, relates to the method of Claim 1, where the machine-resolvable code is a pattern of electromagnetic signals transmitted from an induction-coupled transceiver device and the input device is an electromagnetic signal receiver.[24]

The present invention, as set forth in dependent Claim 13, relates to the method of Claim 1, where the machine-resolvable code is associated with at least a second of the one or more remote locations.[25] The step of transferring is operable to also transfer the sensed machine-resolvable code to the second computer.[26] The step of storing associations comprises storing an association between ones of machine resolvable codes and ones of the one or more remote locations.[27] The step of performing a lookup operation at the second computer further comprises matching the received machine-resolvable code with the associated at least a second of the one or more remote locations to obtain remote routing information corresponding to the associated at least a second of the one or more remote locations.[28]

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[21] See Specification page 45, line 24-page 46, lines 1-23.
[22] See Specification page 45, line 24-page 46, lines 1-23.
[23] See Specification page 45, line 24-page 46, lines 1-23.
[24] See Specification page 45, line 24-page 46, lines 1-23.
[25] See Specification page 47, lines 4-10.
[26] See Specification Figures 25 and 26; and page 47, line 20-page 48, lines 1-2; page 48, lines 3-9; page 48, line 10-page 49, lines 1-5 and page 51, line 15-page 52, lines 1-4.
[27] See Specification page 48, line 10-page 49, lines 1-5; page 50, line 22-page 51, lines 1-14 and page 52, line 22-page 53, lines 1-14.
[28] See Specification page 48, line 10-page 49, lines 1-5; page 49, lines 6-26 and page 52, line 22-page 53, lines 1-14.

The present invention, as set forth in dependent Claim 14, relates to the method of Claim 13, where the step of returning the remote routing information further comprises returning the remote routing information corresponding to the associated at least a second of the one or more remote locations from the second computer to the first computer.[29]

The present invention, as set forth in dependent Claim 15, relates to the method of Claim 14, where the step of accessing with the first computer further comprises the steps of returning information from the associated at least one of the one or more remote locations to the first computer; returning information from the associated second of the one or more remote locations to the first computer; and framing at least a portion of the information from the associated at least one of the one or more remote locations and at least a portion of the information from the associated second of the one or more remote locations in a browser window of the first computer for presentation to the user.[30]

The present invention, as set forth in dependent Claim 16, relates to the method of Claim 1, where the network is a global communication network.[31]

The present invention, as set forth in independent Claim 17, relates to a system for accessing one or more remote locations on a network by sensing a machine-resolvable code.[32] A first computer disposed on the network is provided.[33] The first computer is interfaceable to an input device for sensing a machine-resolvable code[34] proximate a first location. The machine-resolvable code contains no routing information.[35] The first computer runs a software application, which includes a software identification code[36] unrelated to the machine resolvable code having an association with at least one of the one or more remote locations.[37] A second

[29] See Specification page 48, line 10-page 49, lines 1-5; page 49, lines 6-26; page 50, lines 1-21 and page 52, lines 5-21.
[30] See Specification page 50, lines 1-21; page 51, line 15-page 52, lines 1-4 and page 52, lines 5-21.
[31] See Specification Figure 25, Reference # 306; and page 45, lines 7-23; page 48, line 10-page 49, lines 1-5; page 49, lines 6-26; page 50, lines 1-21; page 50, line 22-page 51, lines 1-14 and page 52, lines 5-21.
[32] See Specification Abstract and page 45, lines 7-23.
[33] See Specification page 45, lines 7-23.
[34] See Specification Figure 25, Reference #2506 and page 45, lines 7-23 and page 45, line 24-page 46, lines 1-23.
[35] See Specification page 45, line 24-page 46, lines 1-23; page 48, line 10-page 49, lines 1-5 and page 49, lines 6-26.
[36] See Specification Figure 25, Reference #2522.
[37] See Specification page 45, lines 7-23; page 45, line 24-page 46, lines 1-23; page 47, lines 11-19; page 47, line 20-page 48, lines 1-2; page 48, lines 3-9; page 48, line 10-page 49, lines 1-5 and page 49, lines 6-26.

computer is disposed on the network.[38] It is accessed in accordance with routing information provided by the first computer in response to the input device sensing the machine-resolvable code proximate the first location.[39] The first computer is operable to transfer to the second computer from the first computer at least the software identification code.[40] An associative database is disposed at the second computer for storing associations between software identification codes and ones of the one or more remote locations and is operable to have routing information associated with each of the one or more remote locations.[41] A lookup operation is performed at the second computer to match the software identification code with the associated at least one of the one or more remote locations to obtain associated remote routing information corresponding to the associated at least one of the one or more remote locations.[42] The remote routing information of the at least one of the one or more remote locations is determined at the second computer to correspond to the software identification code that was transferred from the first computer to the second computer.[43] The associated at least one of the one or more remote locations are accessed by the first computer according to the returned remote routing information to retrieve remote information from the one of the one or more remote locations associated with the returned remote routing information.[44]

The present invention, as set forth in dependent Claim 18, relates to the system of Claim 17, where at least a portion of the information returned from the associated at least one of the one or more remote locations to the first computer is presented on the display of the first computer.[45]

The present invention, as set forth in dependent Claim 19, relates to the system of Claim 17, where the software application running on the first computer converts the software

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[38] See Specification page 45, lines 7-23; page 45, line 24-page 46, lines 1-23; page 47, lines 11-19; page 47, line 20-page 48, lines 1-2; page 48, lines 3-9; page 48, line 10-page 49, lines 1-5 and page 49, lines 6-26.
[39] See Specification page 47, lines 11-19; page 48, line 10-page 49, lines 1-5; page 50, lines 1-21 and page 51, line 15-page 52, lines 1-4.
[40] See Specification Figures 25 and 26; and page 47, line 20-page 48, lines 1-2; page 48, lines 3-9; page 48, line 10-page 49, lines 1-5 and page 51, line 15-page 52, lines 1-4.
[41] See Specification page 48, line 10-page 49, lines 1-5; page 50, line 22-page 51, lines 1-14 and page 52, line 22-page 53, lines 1-14.
[42] See Specification page 48, line 10-page 49, lines 1-5; page 49, lines 6-26 and page 52, line 22-page 53, lines 1-14.
[43] See Specification page 48, line 10-page 49, lines 1-5; page 49, lines 6-26; page 50, lines 1-21 and page 52, lines 5-21.
[44] See Specification page 49, lines 6-26; page 50, lines 1-21; page 52, lines 5-21 and page 53, lines 15-25.
[45] See Specification page 49, lines 6-26; page 50, lines 1-21; page 51, line 15-page 52, lines 1-4 and page 52, lines 5-21.

identification code and generates routing information for transmission to the second computer in response to the sensing of a machine-resolvable code by the input device.[46]

The present invention, as set forth in dependent Claim 20, relates to the system of Claim 19, where the routing information includes the software identification code and the address of the second computer.[47]

The present invention, as set forth in dependent Claim 21, relates to the system of Claim 17, where the machine-resolvable code is an optical code and the input device is an optical code scanner.[48]

The present invention, as set forth in dependent Claim 22, relates to the system of Claim 21, where the optical code is a bar code and the optical code scanner is a bar code scanner.[49]

The present invention, as set forth in dependent Claim 23, relates to the system of Claim 22, where the bar code is a universal product code (UPC) bar code.[50]

The present invention, as set forth in dependent Claim 24, relates to the system of Claim 21, where the optical code is alphanumeric text and the optical code scanner is an optical character recognition (OCR) scanner.[51]

The present invention, as set forth in dependent Claim 25, relates to the system of Claim 21, where the optical code is a portion of a display screen displaying a pattern of modulated brightness and the optical code scanner comprises a light sensor.[52]

The present invention, as set forth in dependent Claim 26, relates to the system of Claim 17, where the machine-resolvable code is an audio tone and the input device comprises a microphone.[53]

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[46] See Specification page 47, lines 11-19.
[47] See Specification page 51, line 15-page 52, lines 1-4.
[48] See Specification page 45, line 24-page 46, lines 1-23.
[49] See Specification page 45, line 24-page 46, lines 1-23.
[50] See Specification page 45, line 24-page 46, lines 1-23.
[51] See Specification page 45, line 24-page 46, lines 1-23.
[52] See Specification page 45, line 24-page 46, lines 1-23.
[53] See Specification page 45, line 24-page 46, lines 1-23.

The present invention, as set forth in dependent Claim 27, relates to the system of Claim 17, where the machine-resolvable code is a magnetic pattern in a strip of magnetic material and the input device is a magnetic strip reader.[54]

The present invention, as set forth in dependent Claim 28, relates to the system of Claim 17, where the machine-resolvable code is a pattern of electromagnetic signals transmitted from an induction-coupled transceiver device and the input device is an electromagnetic signal receiver.[55]

The present invention, as set forth in dependent Claim 29, relates to the system of Claim 17, where the machine-resolvable code is associated with at least a second of the one or more remote locations.[56] The first computer is operable to also transfer the sensed machine-resolvable code to the second computer.[57] The associative database is operable to store an association between ones of machine resolvable codes and ones of the one or more remote locations.[58] The second computer performs a lookup operation matching the received machine-resolvable code with the associated at least a second of the one or more remote locations to obtain remote routing information corresponding to the associated at least a second of the one or more remote locations.[59]

The present invention, as set forth in dependent Claim 30, relates to the method of Claim 29, where the second computer returns the remote routing information corresponding to the associated at least a second of the one or more remote locations to the first computer.[60]

The present invention, as set forth in dependent Claim 31, relates to the method of Claim 30, where information from the associated at least one of the one or more remote locations is returned to the first computer; where information from the associated second of the one or more

[54] See Specification page 45, line 24-page 46, lines 1-23.
[55] See Specification page 45, line 24-page 46, lines 1-23.
[56] See Specification page 47, lines 4-10.
[57] See Specification Figures 25 and 26; and page 47, line 20-page 48, lines 1-2; page 48, lines 3-9; page 48, line 10-page 49, lines 1-5 and page 51, line 15-page 52, lines 1-4.
[58] See Specification page 48, line 10-page 49, lines 1-5; page 50, line 22-page 51, lines 1-14 and page 52, line 22-page 53, lines 1-14.
[59] See Specification page 48, line 10-page 49, lines 1-5; page 49, lines 6-26 and page 52, line 22-page 53, lines 1-14.
[60] See Specification page 48, line 10-page 49, lines 1-5; page 49, lines 6-26; page 50, lines 1-21 and page 52, lines 5-21.

remote locations is returned to the first computer; and where at least a portion of the information from the associated at least one of the one or more remote locations and at least a portion of the information from the associated second of the one or more remote locations are framed in a browser window of the first computer for presentation to the user.[61]

The present invention, as set forth in dependent Claim 32, relates to the system of Claim 17, where the network is a global communication network.[62]

The present invention, as set forth in dependent Claim 33, relates to the method of Claim 1, where a remote location is accessible corresponding to each one of the group consisting of the machine-resolvable code, the software identification code and the input device ID.[63]

The present invention, as set forth in dependent Claim 34, relates to the method of Claim 33, where the step of performing a lookup operation includes obtaining routing information for a remote location corresponding respectively to each one of the machine resolvable code, the software identification code, and the input device ID.[64]

The present invention, as set forth in dependent Claim 35, relates to the system of Claim 17, where a remote location is accessible corresponding to each one of the group consisting of said machine-resolvable code, said software identification code and the input device ID.[65]

The present invention, as set forth in dependent Claim 36, relates to the system of Claim 35, where performing said lookup operation includes obtaining routing information for said remote location corresponding respectively to each one of said machine-resolvable code, said software identification code and said input device ID.[66]

VI. Grounds of Rejection to be Reviewed on Appeal.

[61] See Specification page 50, lines 1-21; page 51, line 15-page 52, lines 1-4 and page 52, lines 5-21.
[62] See Specification Figure 25, Reference # 306; and page 45, lines 7-23; page 48, line 10-page 49, lines 1-5; page 49, lines 6-26; page 50, lines 1-21; page 50, line 22-page 51, lines 1-14 and page 52, lines 5-21.
[63] See Specification page 45, lines 7-23; page 46, line 24-page 47, lines 1-3; page 47, lines 4-10; page 48, line 10-page 49, lines 1-5; page 49, lines 6-26; page 50, line 22-page 51, lines 1-14 and page 52, line 22-page 53, lines 1-14.
[64] See Specification page 48, line 10-page 49, lines 1-5; page 49, lines 6-26 and page 52, line 22-page 53, lines 1-14.
[65] See Specification page 45, lines 7-23; page 46, line 24-page 47, lines 1-3; page 47, lines 4-10; page 48, line 10-page 49, lines 1-5; page 49, lines 6-26; page 50, line 22-page 51, lines 1-14 and page 52, line 22-page 53, lines 1-14.
[66] See Specification page 48, line 10-page 49, lines 1-5; page 49, lines 6-26 and page 52, line 22-page 53, lines 1-14.

Claims 1 – 36 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,152,369 to Wilz, Sr. et al. No *prima facie* case as to how Wilz anticipates under 35 U.S.C. § 102(e) has been provided. This rejection is in clear error and should be withdrawn.

VII. Argument and Discussion.

A. Rejections under 35 U.S.C. §102(e)

MPEP §2131 specifies that:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § **2131.02**. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a **35 U.S.C. 102** rejection. See **MPEP § 2131.01**.

Under 35 U.S.C. § 102(e), MPEP §2131.01, the Examiner may combine another reference, which further explains that:

> Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:
> (A) Prove the primary reference contains an "enabled disclosure;"
> (B) Explain the meaning of a term used in the primary reference; or

> (C) Show that a characteristic not disclosed in the reference is inherent.

In order to meet the second criterion for introducing additional references, MPEP §2131.01 II specifies that:

> Extrinsic evidence may be used to explain but not expand the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter.

In order to meet the third criterion for introducing additional references, MPEP §2131.01 III specifies that

> "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.,* 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed.Cir. 1991)

Wilz does not describe each and every element of the claims of the instant application, expressly or inherently. No single prior art reference that anticipates Appellant's present inventive concept as defined by the claims has been provided and the rejection is in error.

B. Decisions Regarding a Finding of Anticipation.

A claimed invention is unpatentable if the differences between it and the prior art are such that "one skilled in the art would reasonably understand or infer from the prior art reference's teaching that every claim [limitation] was disclosed in that single reference."[67] Determining whether a prior art reference discloses each and every limitation of the claim, expressly or inherently, is a factual question reviewed for substantial evidence. This factual question is contingent upon the proper claim construction."[68]

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[67] *Akamai Technologies, Inc v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186, 1192 (Fed. Cir. 2003) (citing *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368 (Fed. Cir. 2003))
[68] *Id.*

Proper claim construction begins with an interpretation of the meaning of the claim language. To ascertain the meaning of claims, the court considers three sources: the claims, the specification, and the prosecution history, as well as extrinsic evidence.[69] In *Lacks Industries, Inc. v. McKechnie Vehicle Components USA, Inc*, 322 F.3d 1335 (Fed. Cir. 2003) the Court noted that, in regards to claim construction:

> ". . . we begin with an examination of the intrinsic evidence, *i.e.*, the claims, the other portions of the specification, and the prosecution history (if in evidence). *Gart v. Logitech, Inc., 254 F.3d 1334, 1339, 59 USPQ2d 1290, 1293-94 (Fed. Cir. 2001)*. Courts may also review extrinsic evidence in construing a claim. *E.g., Spectrum Int'l, Inc. v. Sterilite Corp., 164 F.3d 1372, 1378, 49 USPQ2d 1065, 1068 (Fed. Cir. 1998)*. Additionally, dictionary definitions, although extrinsic, may be used to establish a claim term's ordinary meaning. *Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1584 n.6, 39 USPQ2d 1573, 1580 n.6 (Fed. Cir. 1996)*.."[70]

The court determines if an inventor imparted a novel meaning to the term.[71] As such, the claims are read in light of the specification.[72] *Victronics* further states:

> "the specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication. As we have repeatedly stated, "claims must be read in view of the specification, of which they are a part." The specification contains a written description of the invention which must be clear and complete enough to enable those of ordinary skill in the art to make and use it. Thus, the specification is always relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of the disputed term."[73]

However, during examination, it is well recognized that "the patent application claims may be given their broadest interpretation consistent with the specification, in order to facilitate sharpening and clarifying the claims at the application stage."[74] Thus the patent examiner and

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[69] *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995)
[70] *Lacks Industries, Inc. v. McKechnie Vehicle Components USA, Inc*, 322 F.3d 1335, 1341 (Fed. Cir. 2003)
[71] See generally, *Omega Eng'g v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003)
[72] *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)
[73] *Id.*
[74] *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984) ("The PTO broadly interprets claims during examination of a patent application since the applicant may 'amend his claims to obtain protection commensurate with his actual contribution to the art.'")

the applicant, in the give and take of rejection and response, work toward defining the metes and bounds of the invention to be patented.[75] *Zletz* further states:

> "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."[76]

Therefore, absent evidence that a "patentee unequivocably imparted a novel meaning to [the term] or expressly relinquished claim scope during prosecution," we give the limitation its full ordinary and customary meaning." Dictionary definitions provide evidence of a claim term's "ordinary meaning."[77] Regardless of the method of construction, the construction must be consistent with the language of the claims.[78]

Once the express limitations are construed, the next step is to construe the claims for any inherent limitation. A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present.[79] Anticipation may be established if a missing claim element, although not explicitly present in the reference, is necessarily inherent in it.[80] Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.[81] Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristic or functioning of the prior art. [82] The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient. However, a gap in a reference may be filled with recourse to extrinsic evidence.[83] However, if extrinsic evidence is offered, the extrinsic evidence "must make clear

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[75] *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989)
[76] *Id.* at 322
[77] *Abbott Laboratories v. Syntron Bioresearch, Inc.*, 334 F.3d 1343, 1350 (Fed. Cir. 2003)
[78] *Lacks Industries, Inc. v. McKechnie Vehicle Components USA, Inc*, 322 F.3d 1335, 1343 (Fed. Cir. 2003)
[79] *Rosco v. Mirror Lite*, 304 F.3d 1373, 1380 (Fed. Cir. 2002).
[80] See *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999).
[81] *Id.*
[82] *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, (Fed. Cir. 1999).
[83] *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1267-68 (Fed. Cir. 1991).

that the missing descriptive matter is necessarily present" in the asserted anticipatory reference."[84]

Anticipation is established if every element of a properly construed claim is present in a single prior art reference. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.[85] Therefore, a rejection for anticipation under § 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.[86]

C. 35 U.S.C § 102 Rejection in the Application on Appeal.

The Examiner maintains the 35 U.S.C. § 102(e) rejection of claims 1-36 as being anticipated by *Wilz*.[87] The Examiner has simply construed Appellant's invention in a manner inconsistent with the claims and with the specification to support an anticipation rejection under 35 U.S.C. § 102. In order to establish a *prima facie* case of anticipation using *Wilz*, the Examiner must first show that the reference describes each and every element, expressly or inherently, to support a conclusion of anticipation as it relates to the entire invention. The Examiner may then provide secondary references to illustrate that the primary reference describes a gap, or inherency, in the express limitations. Appellant submits that the Examiner's use of *Wilz* is conclusory, and that no description or teaching in *Wilz* to support the rejection has been provided.

1. Independent Claim 1 as rejected by *Wilz*.

In the Final Office Action mailed October 19, 2007, the Examiner maintains the 35 U.S.C. § 102 rejection of Claims 1-36. On page 2 of the Final Office Action the Examiner states:

> Regarding claim 1, Wilz discloses a method of accessing one or more remote locations on a network by sensing a machine-resolvable code, comprising the steps of:

[84] *Id*.
[85] *Biacore v. Thermo Bioanalysis Corp.*, 79 F. Supp. 2d 422, 459 (D. Del. 1999)
[86] *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994)
[87] See Final Office Action mailed October 19, 2007, page 2, paragraph 2.

providing a first computer disposed on the network, the first computer being interfacable to an input device for sensing a machine resolvable code proximate a first location, the first computer running a software application which includes a software identification code unrelated to the machine resolvable code having an association with at least one of the one or more remote locations (Abstract; Figs. 4, 5, 11A, 11B; col. 27, lines 22 - 62; col. 27, line 63 - col. 28, line 15);

accessing with the first computer a second computer disposed on the network in accordance with routing information provided by the first computer and in response to sensing by the input device the machine-resolvable code proximate the first location; transferring to the second computer from the first computer at least the software identification code (Abstract; Figs. 4, 5; col, 27, line 63 - col. 28, line 15);

storing in an associative database at the second computer associations between software identification codes and ones of the one or more remote locations and operable to have routing information associated with each of the one or more remote locations (Abstract; Fig. 3; col. 27, line 63 - col. 28, line 15);

performing a lookup operation at the second computer to match the software identification code with the associated at least one of the one or more remote locations in accordance with the stored associations to obtain associated remote routing information corresponding to the associated at least one of the one or more remote locations (Abstract; Fig. 3; col. 27, line 63 - col. 28, line 15);

returning to the first computer from the second computer the remote routing information of the at least one of the one or more remote locations determined at the second computer to correspond to the software identification code that was transferred from the first computer to the second computer (Abstract; Fig. 3; col. 27, line 63 - col. 28, line 15); and

accessing with the first computer the associated at least one of the one or more remote locations according to the returned remote routing information to retrieve remote information from the one of the one or more remote locations associated with the returned remote routing information (Abstract; Fig. 3; col. 27, line 63 - col. 28, line 15).[88] (emphasis added)

As such, the Examiner is stating that *Wilz* discloses each and every element of Claim 1 of the instant application.

[88] See Final Office Action dated October 19, 2007 at pages 2-4, paragraph 2.1

2. The Cited References.

In the Response dated August 07, 2007, to the Office Action dated February 07, 2007, the arguments thereof repeated herein, Appellant questions whether *Wilz* anticipates or renders obvious Appellant's invention as set forth in the presented claims.

a. Discussion of U.S. Patent No. 6,152,369 to *Wilz*.

Wilz provides a system and method for storing, accessing, and displaying HTML-encoded documents relating to objects being worked upon in work environments such as inventory management, assembly line and/or plant inspection, and craft or vehicle inspection and/or repair.[89] Specifically, the cited portions of *Wilz* provide a means for a user to track the route and delivery of an object, i.e., a package, via the web.[90]

Wilz teaches a system utilizing a relational database management system.[91] The relational database management system ("RDBMS") software is used to construct a RDBMS within a Routing, Tracking and Delivery ("RTD") server.[92] The RDBMS maintains database records comprising a number of fields, including a package identification field, a URL field, a shipper identification field, a Zip Code field, and a destination field.[93] Each package includes a label containing URL-encoded bar code symbol.[94] When a package is entered into the system, a log-in computer encodes and prints the label including the bar-code symbol with the URL and Zip Code associated with the package identification number.[95] A delivery person can automatically connect with the RTD server and access, to update or change, the data record maintained in the RDBMS of a particular package by reading the bar-code.[96]

Independent Claim 1 of the instant application, as currently presented, is directed to a method for accessing one or more remote locations on a network by sensing a machine-resolvable code. The first step is to provide a first computer disposed on the network. The first computer must be interfaceable to an input device for sensing a machine-resolvable code

[89] See *Wilz*, Abstract; and col. 26, lns. 18-67.
[90] See *Wilz*, col. 27, lns. 15-27.
[91] See *Wilz*, col. 27, lns. 22-24.
[92] See *Wilz*, Fig. 11B; and col. 27, lns. 24-62.
[93] See *Wilz*, col. 29, lns. 44-55.
[94] See *Wilz*, col. 29, lns. 2-29; and col. 30, lns. 1-23.
[95] See *Wilz*, col. 29, lns. 44-54.
[96] See *Wilz*, col. 29, lns. 7-29.

proximate a first location. The first computer runs a software application that includes a software identification code. The software identification code and the machine-resolvable code are unrelated. Additionally, the software identification code has an association with at least one or more remote locations. The Examiner contends that *Wilz* teaches these limitations. However, the cited portions of *Wilz* do not disclose a first computer that runs a software application which includes a software identification code. The cited portions of *Wilz* are:

> A system for storing, accessing and displaying HTML-encoded documents relating to an object being worked upon in a work environment by a human operator. The human operator wears a body-wearable http-enabled client system equipped with a code symbol reader programmed to read a URL-encoded symbol on the object pointing to a HTML-encoded document stored on one or more http-enabled information servers. The http-enabled client system is connected to the information network by a two-way wireless telecommunication link. The code symbol reader is programmed for reading the URL-encoded symbol affixed to the object and automatically produces symbol character data representative of the read code symbol and the URL encoded therewithin. The http-enabled client system also includes a network accessing mechanism and a display device. The network accessing mechanism is programmed for automatically accessing one or more of the HTML-encoded documents from one or more of the http-enabled information servers in response to symbol character data being produced by the code symbol reader. The display device is operably connected to the network accessing mechanism, for visually displaying HTML-encoded documents accessed from the http-enabled information servers in response to symbol character data being produced by the code symbol reader. As a result of the present invention, the human operator is enabled to freely review the HTML-encoded documents displayed on the display device while working with the object in diverse work environments involving, for example, inventory management, assembly-line and/or plant inspection, and craft or vehicle inspection and/or repair.[97]

[97] See *Wilz*, Abstract.

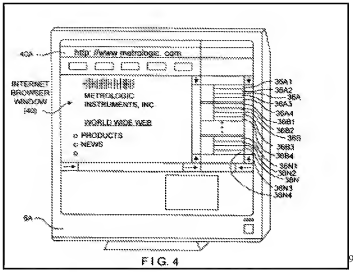

FIG. 4 [98]

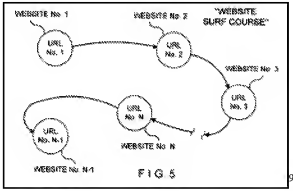

FIG. 5 [99]

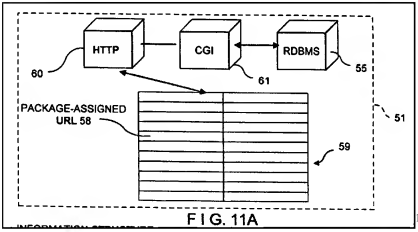

FIG. 11A [100]

[98] See *Wilz*, Fig. 4.
[99] See *Wilz*, Fig. 5.
[100] See *Wilz*, Fig. 11A

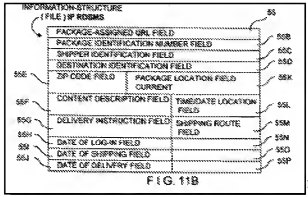

FIG. 11B

The RDBMS software (e.g., 4D Version 6.0 from ACI US, Inc.) is used to construct a RDBMS 55 within or at the back-end of each Internet RTD Server 51. As shown in FIG. 11B, the RDBMS 51 is used to maintain a hypermedia-type relational database containing package shipping, tracking and delivery related information. As shown in FIG. 11B, each database record (i.e., RTD information record) maintained for each package logged-into the system comprises a number of information fields, namely: a URL Field 55A, for storing the URL assigned to each package, at which a static information storage location resides on a web-page on the RTD Internet Server 51; a Package Identification Field 55B for storing a unique number assigned to each package being routed, tracked and delivered within the RTD system hereof; a Shipper Identification Number Field 55C for storing an identifying number assigned to each shipper authorized to ship packages within the RTD system; a Destination Information Field 55D for storing information describing the (initially, past and currently specified) destination(s) of the package; a Zip Code Information Field 55E for storing Zip Code information on the package destination; a Package Content Information Field 55F for storing information regarding the contents of the package; a Delivery Instructions Field 55G for storing delivery instructions (e.g., including graphical maps, audio-based delivery instructions, etc.) for use in delivering the package to its destination; a Date of Log-In Field 55H for storing the date the package is logged-in with the system; a Date of Shipping Field 55I for storing the date the package was shipped (or is expected to be shipped) within the system; a Date of Delivery Field 55J for storing the date the package was delivered (or is expected to be delivered) to its destination; a Package "Goto" Field 55K for storing information on the location of the package within the RTD system; a Time/Date of "Goto" Field 55L for storing information on the time and date of the tracked location of the package within the RTD system; a

[101] See *Wilz*, Fig. 11B

> Shipping Route Field 55M for storing information specifying the planned route of travel assigned to end logged-in package; and Other Information Fields 55N, 550 and 55P for storing various items of information relating to the package description, shipping, tracking and delivery.[102]
>
> In order that each subsystem 52, 53 and 54 can connect with RTD Server 51 and access the RTD information record associated with any package logged-in with the system, the following measures are taken: (1) each logged-in package 56 is labelled with a URL-encoded bar code symbol 57 having an information field structure shown in FIG. 12, as well as a conventional name/address label; and (2) the URL encoded within the bar code symbol is used to specify the location of an information storage field 58 represented on a statically-defined HTML-encoded information field 59 on a web-page stored on the RTD Information Server 51 and served to client subsystems by HTTP Server 60. The size of each Web-based information storage field 58 is sufficient to store ASCII information describing the unique product identification number assigned to the corresponding product being routed and tracked within the system. The RTD information record in the RDBMS 55 associated with any particular package is linked to the URL by the product identification number stored at the information field specified by the URL.[103]

First, the only computer disclosed in the cited portions of *Wilz* to include the software application (i.e. the RDBMS software) is the Internet RTD Server. Clearly, the Examiner is relying upon the RTD Server with the RDBMS software and the information contained therein to teach a first computer running a software application with a software identification code.[104] Therefore, the Examiner relies upon the RTD server as the first computer. However, *Wilz* teaches that a URL encoded bar-code is used to access a location on the RTD server. *Wilz* further discloses that a Package Routing Subsystem also reads the URL encoded bar-code to access the RTD server. *Wilz* Figure 8 illustrates the RTD server, Package Routing Subsystem and other connections of the *Wilz* RTD system.

[102] See *Wilz*, col. 27, lns. 22-62.
[103] See *Wilz*, col. 27, ln 63 – col. 28, ln. 15.
[104] See Final Office Action dated October 19, 2007, page 2 paragraph 2.1 and page 9, paragraph 3.

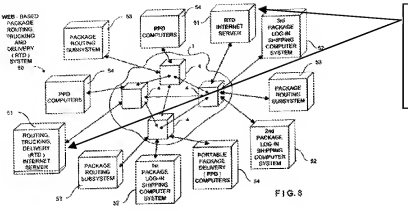

FIG. 8

The Examiner uses as the First Computer running a software application including a software identification code.

105

Clearly, this is in contradiction to the claims of the instant application that requires "the first computer, running a software application ... accessing ... a second computer ... [and] storing in an associative database on the second computer." The first computer must include the software application, including the software identification code and the second computer, which is accessed by the first computer, includes the database. However, *Wilz* teaches that the RTD server, which is accessed by the other computers, includes the RDBMS software which is also the relational database.[106] Therefore, *Wilz* does not teach a first computer running a software application that includes a software identification code and a second computer containing an associative database as found in Claim 1.

Further, *Wilz* contains no disclosure regarding a software application that includes a software identification code. The *Wilz* software application, relied upon by the Examiner, is the RDBMS software stored on the RTD server. Appellant previously noted that the RDBMS is merely a database.[107] This database contains database records relating to the shipping, tracking and delivery of packages.[108] Regardless, the Examiner contends that the software identification code can possibly be interpreted as one of the fields in Figure 11B. The Examiner states:

> Applicant argues that Wilz (U.S. Pat. No. 6,152,369) does not disclose the feature a "software identification code unrelated to the machine resolvable code." (p. 11 of arguments on 8/2/07).

[105] See *Wilz*, Figure 8.
[106] See *Wilz*, col. 27, ln. 63 – col. 28, ln. 8.
[107] See Response to Office Action dated August 07, 2007, page 11.
[108] See *Wilz*, col. 17, lns. 25-28.

Examiner disagrees.

> Examiner notes that the terms "**software identification code**" and "**unrelated**" are not well defined in the specification of the present Application.
>
> Therefore, the "software identification code" of claim 1 and claim 17 can possibly be interpreted as one of the fields in Figure 11 B."[109] (emphasis original)

However, the specification clearly teaches in paragraphs [0072], [0074], [0075], [0076], [0077], [0079] and [0080] that there exists a software application, which includes a software identification code, and there exists a machine-resolvable code as separate elements that have no relationship with each other. Further, both terms "software identification code" and "unrelated" appear in the originally filed Claims 1 and 17 and are considered part of the originally filed patent application. Exercising proper claim construction, even if the Examiner is unable to find where Appellant unequivocably imparted novel meaning to the terms within the specification, the Examiner must give the terms their "full ordinary and customary meaning." One skilled in the art at the time of the invention would recognize that the full ordinary and customary meaning of Software Identification Code is a code that serves to identify the software. The full ordinary and customary meaning of "unrelated" would be having no connection by reason of an established or discoverable relation.

Even if the Examiner's contention is followed, the construction of the terms would be inconsistent with the language of the claim. Regardless of the method of construction, the construction must be consistent with the language of the claims.[110] The Examiner contends that the "software identification code" can possibly be interpreted as one of the fields in Figure 11B. The fields in Figure 11B of *Wilz* are: package assigned URL field; package identification number field; shipper identification field; destination field; zip code field; package location field current; content description field; time/date location field; delivery instruction field; shipping route field; date of log-in field; date of shipping field; and date of delivery field. *Wilz* teaches that all of these fields are specifically related to the machine-readable code wherein *Wilz* discloses that

[109] See Final Office Action dated October 19, 2007 page 9, paragraph 3.
[110] *Lacks Industries, Inc. v. McKechnie Vehicle Components USA, Inc*, 322 F.3d 1335, 1343 (Fed. Cir. 2003)

each of these fields is contained as part of a database record in a relational database.[111] Clearly this is contrary to the plain language of the claim requiring that the software identification code be "unrelated" to the machine-resolvable code and, as such, is clear error.

The software identification code must have an association with at least one of the one or more remote locations. The claim also requires that the second computer returns the remote routing information of the at least one or more remote locations. However, the fields relied upon by the Examiner are associated with a URL, which is also encoded within the bar-code, that specifies the location of the fields. *Wilz* teaches this URL as "assigned to each package, at which a static information storage location resides on a web-page on the RTD Internet Server 51."[112] Clearly, the fields are not associated with one or more remote locations. As such, the Examiner's use of any of the fields of Figure 11B as the software identification code is contrary to the language of the claim and is clear error.

Further, the claim requires transferring the software identification code to a second computer from the first computer. The Examiner couples this limitation with the previous limitation of "accessing with the first computer a second computer disposed on the network in accordance with routing information provided by the first computer and in response to sensing by the input device the machine-resolvable code proximate the first location. As such, the Examiner provides *Wilz*, Abstract, Figures 4 and 5, and column 27, line 63 – column 28 line 15 for this teaching. The cited portions of *Wilz* do not disclose the transferring of a software identification code, or any of the fields of Figure 11B. Specifically, *Wilz* teaches that a Package Routing Subsystem reads the URL encoded bar-code and obtains the information representative of the URL and Zip-Code. Thereafter, the Routing Subsystem uses the obtained URL to access the RTD Internet Server. The relevant portions of *Wilz* state:

> As each package is scanned by the bar code symbol reader 53A at a Package Routing Subsystem, a package routing/tracking procedure is automatically carried out. This procedure is outline in the flow chart of FIG. 14 described below.
>
> As indicated at Block A of FIG. 14, the bar code scanner at the Package Routing Subsystem reads the URL/ZIP-CODE encoded bar code symbol on the package and obtains the

[111] See *Wilz*, col. 27, ln. 15 – col. 28, ln. 15.
[112] See *Wilz*, col. 27, lns. 30-33.

> information representative of the URL and the Zip Code. Then, at Block B, the Package Routing Subsystem uses the locally-recovered Zip Code to route the package at the Package Routing Subsystem at the hub station of the system. Then at Block C, the Routing Subsystem uses the obtained URL to access the RTD Internet Server by way of HTTP and update the location of the scanned package within the RDBMS of the system. Each time the package is scanned at a different Package Routing Subsystem, or other Internet Access Terminal located within the RTD system, the current location of the scanned package within the System is updated, by ensuring that each HTTP request sent to the RTD Internet Server (by the Package Routing Subsystem) includes information identifying the requesting Package Routing Subsystem.[113] (emphasis added)

Clearly, the cited portions of *Wilz* do not disclose that any information is transferred from a first computer to a second computer. The only information that is used is the URL (58), which is encoded within the bar-code. *Wilz* does not teach "transferring to the second computer from the first computer at least the software identification code."

The Claim further requires "storing in an associative database at the second computer associations between software identification codes and ones of the one or more remote locations and operable to have routing information associated with each of the one or more remote locations." The Examiner contends that *Wilz* discloses this limitation in the Abstract, Figure 3 and column 27, line 63 – column 28, line 15. As Appellant previously stated, the cited portions of *Wilz* contain no disclosure that there is some association of a software identification code and ones of the one or more remote locations stored in the database. The database only stores an association between a URL and a particular package identified by a product identification.[114] The only location information disclosed is that which is on the package and encoded within the bar-code, which is the location of the database record itself.[115] *Wilz* does not teach this limitation and the Examiner's reliance upon the cited portions of *Wilz* is clear error.

The claim further recites "performing a lookup operation at the second computer to match the software identification code with the associated at least one of the one or more remote locations in accordance with the stored associations to obtain associated remote routing

[113] See *Wilz*, col. 30, lns. 1-23.
[114] See Response dated August 07, 2007, page 12.
[115] See *Wilz*, col. 28, lns. 11-14.

information corresponding to the associated at least one of the one or more remote locations." As stated herein and in Appellant's previous Response, *Wilz* merely teaches that the URL is a pointer to a record in a database.[116] There is no matching operation taught or suggested in *Wilz*. As such, the cited portions of *Wilz* do not teach this limitation and the Examiner's reliance on these cited portions is clear error.

The next step in the claim is "returning to the first computer from the second computer the remote routing information of the at least one of the one or more remote locations determined at the second computer to correspond to the software identification code that was transferred from the first computer to the second computer." Thereafter, the claim requires "accessing with the first computer the associated at least one of the one or more remote locations according to the returned remote routing information to retrieve remote information from the one of the one or more remote locations associated with the returned remote routing information." Since *Wilz* does not disclose the software identification code and the corresponding steps of transferring and matching (performing a lookup operation), *Wilz* cannot disclose these remaining limitations. Reliance on *Wilz* for these teachings is clear error.

Thus, to apply *Wilz* for the purpose of anticipating Claim 1 in the present application, the Examiner must show that *Wilz* teaches, expressly or inherently, each and every element of Appellant's present claims such that one skilled in the art would see no difference between the instant application and the cited reference. *Wilz* does not meet this requirement.

3. Conclusion

Wilz provides a system with an Internet Server that includes a Relational Database Management System ("RDBMS") software. A first terminal reads a URL encoded bar-code on a package. The first terminal obtains a URL from reading the URL encoded bar-code. The terminal use the URL to access a record in the RDBMS located on the Internet Server. The record accessed contains information regarding the package such as package ID, shipping ID, and destination.

[116] See Response dated August 07, 2007, page 12.

The Examiner's position is conclusory. The Examiner contends that the *Wilz* RTD Server with the RDBMS software is a first computer, disposed on the network, running a software application that includes a software identification code. The Examiner has not directed Appellant to any teaching in *Wilz* that discloses that the RTD server accesses a second computer on the network in accordance with routing information provided by the RTD Server ("the first computer") and in response to sensing, by an input device, a machine-resolvable code proximate the RTD Server location ("first location"). The Examiner has construed the term "software identification code" in a manner inconsistent with the specification and the full ordinary and customary meaning of the term. The Examiner's interpretation of the term "software identification code" is inconsistent with the language of the claim. The Examiner clearly has erred in his claim construction of Independent Claim 1 in regard to his interpretation of the first computer, second computer, software application, software identification and definition of the term "unrelated." In summary, Appellant submits that the Examiner has erroneously construed Independent Claim 1 and has failed to provide a *prima facie* case as to why *Wilz* anticipates Appellant's present inventive concept, as defined by Claim 1.

D. Independent Claim 17 as rejected as being anticipated by *Wilz*.

Independent Claim 17 is directed to a system for accessing one or more remote locations on a network by sensing a machine-resolvable code. The system includes a first computer disposed on the network, the first computer being interfaceable to an input device for sensing a machine-resolvable code proximate a first location, wherein the machine-resolvable code contains no routing information. The first computer running a software application which includes a software identification code unrelated to the machine resolvable code and having an association with at least one of the one or more remote locations. The system includes *a second computer* disposed on the network. The second computer is accessed in accordance with routing information provided by the first computer and in response to the input device sensing the machine-resolvable code proximate the first location. The first computer is operable to transfer to the second computer, from the first computer, at least the software identification code. The second computer having an associative database for storing associations between software identification codes and ones of the one or more remote locations and operable to have routing information associated with each of the one or more remote locations. A lookup operation is

performed at the second computer to match the software identification code with the associated at least one of the one or more remote locations to obtain associated remote routing information corresponding to the associated at least one of the one or more remote locations. Further, the remote routing information of the at least one of the one or more remote locations determined at the second computer to correspond to the software identification code that was transferred from the first computer to the second computer is returned from the second computer to the first computer. The associated at least one of the one or more remote locations are accessed by the first computer according to the returned remote routing information to retrieve remote information from the one of the one or more remote locations associate with the returned remote routing information.

Independent Claim 17 contains limitations as found in Independent Claim 1. Therefore, Independent Claim 17 is allowable for at least the same reasons as Independent Claim 1.

E. Dependent Claims 2 and 18 as rejected as being anticipated by *Wilz*.

The Examiner stated in the Final Office Action, mailed November 16, 2006:

> Per claim 2, Wilz teaches, the method of claim 1, wherein the step of accessing with the first computer further comprises the steps of:
>
> returning information from the associated at least one of the one or more remote locations to the first computer (Abstract; Figs. 4, 5; col. 27, line 63 - col. 28, line 15); and
>
> presenting at least a portion of the information so returned on the display of the first computer for presentation to the user (Abstract; Figs. 4, 5; col. 27, line 63 - col. 28, line 15).[117]

Claim 2 depends from, and further limits, Independent Claim 1, while Claim 18 depends from, and further limits, Independent Claim 17. These dependent claims are allowable for at least the same reasons as the claims from which they depend, as discussed above.

F. Dependent Claims 3 and 19 as rejected as being anticipated by *Wilz*.

The Examiner stated in the Final Office Action, mailed October 19, 2007:

[117] See Final Office Action mailed October 19, 2007, page 4, paragraph 2.2.

> Regarding claim 3, Wilz discloses the method of claim 1 [sic] wherein in response to the sensing of a machine-resolvable code using the input device, the software application running on the first computer converts the software identification code and generates routing information for transmission to the second computer (Abstract; Figs. 4, 5; col. 27, line 63 - col. 28, line 15).[118] (emphasis added)

The Examiner again provides the Abstract, Figures 4 and 5, and column 27, line 63 – column 28, line 15 of *Wilz* to teach this limitation. However, the cited portions of *Wilz* contain no disclosure that a software identification code, or any code or field, is converted and routing information generated for transmission to a second computer. *Wilz* merely teaches, and is limited to teaching, that a URL encoded bar-code is read and the URL is obtained to be used to specify the location of an information storage field. The Examiner has not directed Appellant to any teaching to support a rejection of this limitation. Appellant submits that the Examiner has failed to provide a *prima facie* case as to why *Wilz* anticipates Appellant's present inventive concept, as defined by Claims 3 and 19.

Further, Claim 3 depends from, and further limits, Independent Claim 1, while Claim 19 depends from, and further limits, Independent Claim 17. These dependent claims are allowable for at least the same reasons as the claims from which they depend, as discussed above.

G. Dependent Claims 4-8, 11-16, 20-24 and 27-36 as rejected as being anticipated by *Wilz*.

Claims 4-8, 11-16 and 33-34 depend from, and further limit, Independent Claim 1, while Claims 20-24, 27-32 and 35-36 depend from, and further limit, Independent Claim 17. These dependent claims are allowable for at least the same reasons as the claims from which they depend, as discussed above.

H. Dependent Claims 9 and 25 as rejected as being anticipated by *Wilz*.

The Examiner stated in the Final Office Action, mailed October 19, 2007:

> Regarding claim 9, Wilz discloses the method of claim 5, wherein the optical code is a portion of a display screen displaying a pattern

[118] See Final Office Action mailed October 19, 2007, page 4, paragraph 2.2.

> of modulated brightness and the optical code scanner comprises a light sensor (col. 3, lines 5 - 12; col. 4, lines 8 – 19).[119]

Dependent Claim 9, of the instant application, is directed to the method of Claim 5 wherein the optical code is a portion of a display screen displaying a pattern of modulated brightness and the optical code scanner comprises a light sensor. Dependent Claim 25 is directed towards a system of Claim 21 wherein the optical code is a portion of a display screen displaying a pattern of modulated brightness and the optical code scanner comprises a light sensor. The Examiner contends that Wilz anticipates these limitations. As such, the Examiner contends that there is no difference between these claims and the cited portions of Wilz, as viewed by one of ordinary skill in the field of the invention. The cited portions of Wilz state:

> A further object of the present invention is to provide such an Internet Access System, wherein the DN-encoded bar code symbol printed on various types of print media is a DN/PN-encoded truncated-type bar code symbol, having a very low height to length ratio, thereby allowing many URL-encoded bar code symbols to be printed on a single sheet or page of a Web-site guide, along with their corresponding human-readable URLs and content descriptions.[120] (emphasis added)

> A further object of the present invention is to provide an Internet Access System in the form of an interactive web-based television system, wherein the web-based television system comprises an Internet terminal unit connected to the Internet by way of an ISP, an audio-visual (AV) display monitor for displaying graphical and audio information content of Web-sites, and a portable Internet surfing device having a wireless IR-based communication link to the Internet Terminal unit and an integrated optical character reader for automatically surfing to Web-sites listed in a Web-site guide by simply scanning corresponding URLs printed on the pages thereof.[121] (emphasis added)

The cited portions of *Wilz* merely teach URL encoded bar-codes printed on pages of a web-guide wherein a bar-code scanner is used to read the bar-code and obtain the URLs to cause a Internet terminal to access a site corresponding to the URL. The Examiner has erroneously construed to claims and provided a reference to printed media in *Wilz* to teach a pattern of

[119] See Final Office Action mailed October 19, 2007, page 6, paragraph 2.9.
[120] See *Wilz*, col. 3, lns. 5-12.
[121] See *Wilz*, col. 4, lns. 8-19.

modulated brightness displayed on a display screen wherein a light sensor is used to read the pattern of modulate brightness. The cited portions of *Wilz* simply do not disclose an optical code as part of a display screen displaying a pattern of modulated brightness and an optical code scanner that is a light sensor. The Examiner has not directed Appellant to any teaching to support a rejection of this limitation. Appellant submits that the Examiner has erroneously construed dependent claims 9 and 25 and has failed to provide a *prima facie* case as to why *Wilz* anticipates Appellant's present inventive concept, as defined by Claims 9 and 25.

Further, Claim 9 depends from, and further limits, Independent Claim 1, while Claim 25 depends from, and further limits, Independent Claim 17. These dependent claims are allowable for at least the same reasons as the claims from which they depend, as discussed above.

I. Dependent Claims 10 and 26 as rejected as being anticipated by *Wilz*.

The Examiner stated in the Final Office Action, mailed November 16, 2006:

> Per claim 10, Wilz teaches the method of claim 1, wherein the machine-resolvable code is an audio tone and the input device comprises a microphone (col. 36, lines 11 - 33; Fig. 19).[122]

Dependent Claim 10, of the instant application, is directed to the method of Claim 1 wherein the machine-resolvable code is an audio tone. The Examiner contends that *Wilz* teaches this limitation at column 36, lines 11-33 and Figure 19. The cited portions of *Wilz* state:

> In alternative embodiment of the present invention, a large-vocabulary speech recognition subsystem may be integrated within the remote housing 42 so that the user can enter information to the Internet browser by speaking rather than through manual keystroke, or pen computing techniques well known in the art and supported by the microcomputing platform contained within the remote housing.
>
> In some applications, it may also be desirable to mount the bar code symbol reader 20 on the finger or head of the operator and/or mount the remote housing 72 on a different portion of the operator's body (e.g., leg or waist). It may also be desirable to integrated all of the components of the system into a single housing worn on a specific portion of the operator's body.

[122] See Final Office Action mailed October 19, 2007, page 6, paragraph 2.9.

In some applications, it may be desirable to provide a lightweight headset having a miniature LCD display screen 77, a microphone 78, and earphones 79, while providing the remote unit 72 with audio and video input/output ports 80 for supplying audio input to the microcomputing platform (within the remote unit) and audio and video output therefrom for driving the headset worn by the operator during in-field use of the system, using a flexible communication cable 81, as shown in FIGS. 18 and 19.[123] (emphasis added)

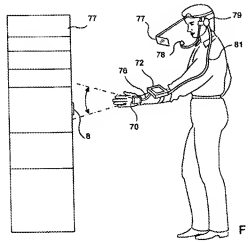

FIG. 19

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Clearly, the cited portions of *Wilz* disclose a microphone (78) for detecting voice inputs from a user and a scanner (70)[125] for reading a bar-code (machine-resolvable code). The Examiner has construed the terms "machine-resolvable code is an audio tone" to be a human voice. One of ordinary skill in the art at the time of the invention would recognize that a human voice is not a machine-resolvable code. The cited portions of *Wilz* simply do not teach a machine-resolvable code that is an audio tone. Appellant submits that the Examiner has erroneously construed dependent claims 10 and 26 and has failed to provide a *prima facie* case as to why *Wilz* anticipates Appellant's present inventive concept, as defined by Claims 10 and 26.

Further, Claim 10 depends from, and further limits, Independent Claim 1, while Claim 26 depends from, and further limits, Independent Claim 17. These dependent claims are allowable for at least the same reasons as the claims from which they depend, as discussed above.

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[123] See *Wilz*, col. 36, lns. 11-33.
[124] See *Wilz*, Fig. 19.
[125] See also, *Wilz*, col. 35, lns. 45-47 stating: "Optionally, a laser scanning bar code symbol scanner (without a digitizer or decoder) 20' can be contained within hand-mounted unit 70..."

VIII. Conclusion

In Summary, Appellant submits that the single reference cited by the Examiner fails to anticipate Appellant's inventive concept as defined by the presented claims. Further, the cited reference fails to teach each and every limitation, expressly or inherently because the text fails to illustrate "why" one skilled in the art would see no difference between the instant application and the cited reference. Instead, the Examiner simply identifies particular components from the reference, erroneously construes the limitations required by Appellant's claimed invention, and then states that the cited reference anticipates. This is clearly conclusory reasoning that contravenes the standards imposed by both the MPEP and the Federal Circuit, and Appellant respectfully submits that the cited reference is improper for the reasons detailed above and requests that the rejections under § 102 and objections be withdrawn.

Respectfully submitted,

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CLAIMS APPENDIX

1. A method of accessing one or more remote locations on a network by sensing a machine-resolvable code, comprising the steps of:

providing a first computer disposed on the network, the first computer being interfacable to an input device for sensing a machine-resolvable code proximate a first location, the first computer running a software application which includes a software identification code unrelated to the machine resolvable code having an association with at least one of the one or more remote locations;

accessing with the first computer a second computer disposed on the network in accordance with routing information provided by the first computer and in response to sensing by the input device the machine-resolvable code proximate the first location;

transferring to the second computer from the first computer at least the software identification code;

storing in an associative database at the second computer associations between software identification codes and ones of the one or more remote locations and operable to have routing information associated with each of the one or more remote locations;

performing a lookup operation at the second computer to match the software identification code with the associated at least one of the one or more remote locations in accordance with the stored associations to obtain associated remote routing information corresponding to the associated at least one of the one or more remote locations;

returning to the first computer from the second computer the remote routing information of the at least one of the one or more remote locations determined at the second computer to correspond to the software identification code that was transferred from the first computer to the second computer; and

accessing with the first computer the associated at least one of the one or more remote locations according to the returned remote routing information to retrieve remote information from the one of the one or more remote locations associated with the returned remote routing information .

2. The method of Claim 1, wherein the step of accessing with the first computer further comprises the steps of:

returning information from the associated at least one of the one or more remote locations to the first computer; and

presenting at least a portion of the information so returned on the display of the first computer for presentation to the user.

3. The method of Claim 1, wherein in response to the sensing of a machine-resolvable code using the input device, the software application running on the first computer converts the software identification code and generates routing information for transmission to the second computer.

4. The method of Claim 3, wherein the routing information includes the software identification code and the address of the second computer.

5. The method of Claim 1, wherein the machine-resolvable code is an optical code and the input device is an optical code scanner.

6. The method of Claim 5, wherein the optical code is a bar code and the optical code scanner is a bar code scanner.

7. The method of Claim 6, wherein the bar code is a universal product code (UPC) bar code.

8. The method of Claim 5, wherein the optical code is alphanumeric text and the optical code scanner is an optical character recognition (OCR) scanner.

9. The method of Claim 5, wherein the optical code is a portion of a display screen displaying a pattern of modulated brightness and the optical code scanner comprises a light sensor.

10. The method of Claim 1, wherein the machine-resolvable code is an audio tone and the input device comprises a microphone.

11. The method of Claim 1, wherein the machine-resolvable code is a magnetic pattern in a strip of magnetic material and the input device is a magnetic strip reader.

12. The method of Claim 1, wherein the machine-resolvable code is a pattern of electromagnetic signals transmitted from an induction-coupled transceiver device and the input device is an electromagnetic signal receiver.

13. The method of Claim 1, wherein:

the machine-resolvable code is associated with at least a second of the one or more remote locations;

the step of transferring is operable to also transfer the sensed machine-resolvable code to the second computer;

the step of storing associations comprises storing an association between ones of machine resolvable codes and ones of the one or more remote locations; and

the step of performing a lookup operation at the second computer further comprises matching the received machine-resolvable code with the associated at least a second of the one or more remote locations to obtain remote routing information corresponding to the associated at least a second of the one or more remote locations.

14. The method of Claim 13, wherein the step of returning the remote routing information further comprises returning the remote routing information corresponding to the associated at least a second of the one or more remote locations from the second computer to the first computer.

15. The method of Claim 14, wherein the step of accessing with the first computer further comprises the steps of,

returning information from the associated at least one of the one or more remote locations to the first computer;

returning information from the associated second of the one or more remote locations to the first computer; and

framing at least a portion of the information from the associated at least one of the one or more remote locations and at least a portion of the information from the associated second

of the one or more remote locations in a browser window of the first computer for presentation to the user.

16. The method of Claim 1,wherein the network is a global communication network.

17. A system for accessing one or more remote locations on a network by sensing a machine-resolvable code, comprising:

a first computer disposed on the network, the first computer being interfacable to an input device for sensing a machine-resolvable code proximate a first location, wherein the machine-resolvable code contains no routing information, the first computer running a software application which includes a software identification code unrelated to the machine resolvable code having an association with at least one of the one or more remote locations;

a second computer disposed on the network, and accessed in accordance with routing information provided by said first computer and in response to the input device sensing the machine-resolvable code proximatethe first location;

the first computer operable to transfer to the second computer from the first computer at least the software identification code;

an associative database disposed at the second computer for storing associations between software identification codes and ones of the one or more remote locations and operable to have routing information associated with each of the one or more remote locations;

wherein a lookup operation is performed at the second computer to match the software identification code with the associated at least one of the one or more remote locations to obtain associated remote routing information corresponding to the associated at least one of the one or more remote locations;

wherein the remote routing information of the at least one of the one or more remote locations determined at the second computer to correspond to the software identification code that was transferred from the first computer to the second computer; and

wherein the associated at least one of the one or more remote locations are accessed by the first computer according to the returned remote routing information to retrieve remote information from the one of the one or more remote locations associated with the returned remote routing information.

18. The system of Claim 17, wherein at least a portion of the information returned from the associated at least one of the one or more remote locations to the first computer is presented on the display of the first computer.

19. The system of Claim 17, wherein the software application running on the first computer converts the software identification code and generates routing information for transmission to the second computer in response to the sensing of a machine-resolvable code by the input device.

20. The system of Claim 19, wherein the routing information includes the software identification code and the address of the second computer.

21. The system of Claim 17, wherein the machine-resolvable code is an optical code and the input device is an optical code scanner.

22. The system of Claim 21, wherein the optical code is a bar code and the optical code scanner is a bar code scanner.

23. The system of Claim 22, wherein the bar code is a universal product code (UPC) bar code.

24. The system of Claim 21, wherein the optical code is alphanumeric text and the optical code scanner is an optical character recognition (OCR) scanner.

25. The system of Claim 21, wherein the optical code is a portion of a display screen displaying a pattern of modulated brightness and the optical code scanner comprises a light sensor.

26. The system of Claim 17, wherein the machine-resolvable code is an audio tone and the input device comprises a microphone.

27. The system of Claim 17, wherein the machine-resolvable code is a magnetic pattern in a strip of magnetic material and the input device is a magnetic strip reader.

28. The system of Claim 17, wherein the machine-resolvable code is a pattern of electromagnetic signals transmitted from an induction-coupled transceiver device and the input device is an electromagnetic signal receiver.

29. The system of Claim 17, wherein:

the machine-resolvable code is associated with at least a second of the one or more remote locations;

the first computer is operable to also transfer the sensed machine-resolvable code to the second computer ;

said associative database operable to store an association between ones of machine resolvable codes and ones of the one or more remote locations; and

wherein the second computer performs a lookup operation matching the received machine-resolvable code with the associated at least a second of the one or more remote locations to obtain remote routing information corresponding to the associated at least a second of the one or more remote locations.

30. The method of Claim 29, wherein the second computer returns the remote routing information corresponding to the associated at least a second of the one or more remote locations to the first computer.

31. The method of Claim 30, wherein information from the associated at least one of the one or more remote locations is returned to the first computer; wherein information from the associated second of the one or more remote locations is returned to the first computer; and wherein at least a portion of the information from the associated at least one of the one or more remote locations and at least a portion of the information from the associated second of the one or more remote locations are framed in a browser window of the first computer for presentation to the user.

32. The system of Claim 17,wherein the network is a global communication network.

33. The method of Claim 1, wherein a remote location is accessible corresponding to each one of the group consisting of the machine-resolvable code, the software identification code and the input device ID.

34. The method of Claim 33, wherein the step of performing a lookup operation includes obtaining routing information for a remote location corresponding respectively to each one of the machine resolvable code, the software identification code and the input device ID.

35. The system of Claim 17, wherein a remote location is accessible corresponding to each one of the group consisting of said machine-resolvable code, said software identification code and said input device ID.

36. The system of Claim 35, wherein performing said lookup operation includes obtaining routing information for said remote location corresponding respectively to each one of said machine-resolvable code, said software identification code and said input device ID.

EVIDENCE APPENDIX

A. U.S. Patent No. 6,152,369 to Wilz, Sr. et al. ("Wilz") found on pages 4-11 of the Office Action (dated February 7, 2007), and found on pages 2-9 of the Office Action (dated October 19, 2007).

B. *Abbott Laboratories v. Syntron Bioresearch, Inc.*, 334 F.3d 1343, 1350 (Fed. Cir. 2003)

C. *Akamai Technologies, Inc v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186, 1192 (Fed. Cir. 2003)

D. *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999)

E. *Biacore v. Thermo Bioanalysis Corp.*, 79 F. Supp. 2d 422, 459 (D. Del. 1999)

F. *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1267-68 (Fed. Cir. 1991)

G. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368 (Fed. Cir. 2003)

H. *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994)

I. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984)

J. *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989)

K. *Lacks Industries, Inc. v. McKechnie Vehicle Components USA, Inc*, 322 F.3d 1335 (Fed. Cir. 2003)

L. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995)

M. *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, (Fed. Cir. 1999)

N. *Omega Eng'g v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003)

O. *Rosco v. Mirror Lite*, 304 F.3d 1373, 1380 (Fed. Cir. 2002)

P. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)

RELATED PROCEEDINGS APPENDIX

None.